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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,892	03/25/2004	Jeffrey D. Ollis	BCS03496	7408

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GENERAL INSTRUMENT CORPORATION
101 Tournament Drive
Horsham, PA 19044

EXAMINER

MANCHO, RONNIE M

ART UNIT	PAPER NUMBER
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3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/808,892

Applicant(s)

OLLIS ET AL.

Examiner

Ronnie Mancho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Simonds et al (US 2004/0093154).

Regarding claim 1, Simonds et al (figs. 1, 2, abstract; section. 0012-0014, 0040, 0042, 0109, 0111, 0114-116) disclose a system for dynamic alternative geographic route plotting using global positional satellite data, said system comprising:

an audio tuner 34 (figs 1&2), said audio tuner tuning frequencies for reception of radio broadcast signals;

a selection recognition engine 30 coupled to said audio tuner 34, said selection recognition engine 30 monitoring said radio broadcast signals (sec 0038, 0042) for pre-defined recording triggers (presence or availability of info; sec 0042) and selectively recording portions of a radio broadcast signal (sec 0012-0014), said selection recognition engine extracting anomaly information (weather, traffic, etc; sec 0042) from said recorded portions using voice recognition (sec. 0036, 0075); and

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a global positional satellite device 42 (fig. 1), said global positional satellite device receiving said anomaly information and generating at least one alternative route in response to said anomaly information (road construction, etc; sec 0116).

Regarding claim 2, Simonds et al (figs. 1, 2, abstract; section. 0012-0014, 0040, 0042, 0109, 0111, 0114-116) disclose the system of claim 1 further comprising an audio capture memory coupled to said selection recognition engine, said audio capture memory storing recorded portions of said radio broadcast signal (sec. 0012-0014).

Regarding claim 3, Simonds et al (figs. 1, 2, abstract; section. 0012-0014, 0040, 0042, 0109, 0111, 0114-116) disclose the system of claim 2, wherein said audio capture memory comprises at least one of random access memory, flash memory, a hard drive, optical drive, and optical-magnetic drive (sec 0039).

Regarding claim 4, Simonds et al (figs. 1, 2, abstract; section. 0012-0014, 0040, 0042, 0109, 0111, 0114-116) disclose the system of claim 1 wherein said radio broadcast signal comprises a primary band signal.

Regarding claim 5, Simonds et al (figs. 1, 2, abstract; section. 0012-0014, 0040, 0042, 0109, 0111, 0114-116) disclose the system of claim 1 further comprising a display.

MPEP 2114

The statement of intended use or field of use, "tuning frequencies for", "monitoring radio broadcast signals for", "recording/storing portions of", "extracting/receiving anomaly information from", "using voice recognition", etc clauses are essentially method limitation or statement of intended or desired use. Thus, the claim as well as other statements of intended use

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do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647. See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Response to Arguments

3. Applicant's arguments filed 1/25/07 have been fully considered but they are not persuasive.

The 112 rejection drawn to the phrase, “primary band signal” has been withdrawn in view of applicant’s admission that the phrase, “primary band signal” is prior art. The rest of the 112 rejections have been withdrawn in view of applicant’s argument.

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Applicant argues that the prior art does not disclose “using voice recognition to extract the anomaly information” as amended in the claims. The examiner disagrees. First of all, the phrase is intended use or method step in an apparatus claim and does not further distinguish the structure of the invention over the prior art. It is further noted that the prior art disclose “using voice recognition to extract anomaly information” in sections 0036, 0075, etc. The prior art discloses, using an audio input device that allows for voice speech recognition as a means to provide *audio command inputs* to the system. The commands as disclosed in the prior art include extracting anomaly information such weather, traffic, etc; see section 0042, etc.

The applicant further argues that the MPEP 2114 citation is inappropriate because the intended use limitations or functional language further define the structure of the apparatus as claimed. The examiner disagrees. The intended use limitations do not further define the structure as claimed. The limitations only provide the intended use or how the structure is to be used, thus not providing any further structure over the prior art. Applicant further states that intended use limitations are not to be disregarded in the claims. The examiner notes that the functional language or intended use limitations were not disregarded as purported by the applicant. Applicant was not required to cancel the functional language limitations. It was pointed out that the functional limitations do not impart any further patentably distinguishable structural feature over the prior art.

Applicant may use language such as “configured to extract”, configured to tune frequencies”, etc to overcome the MPEP 2114 citation.

It is believed that the rejections are proper and thus stand.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Communication

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho
Examiner
Art Unit 3663

4/13/07


JACK KEITH
SUPERVISORY PATENT EXAMINER